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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,488	02/11/2002	George Jyh-Shann Chou	17714 (MHM 13417US01)	6030

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EXAMINER
WYSZOMIERSKI, GEORGE P

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/073,488	CIOCIRLAN ET AL.	
	Examiner	Art Unit	
	George P Wyszomierski	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) *19-28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,13 and 16* is/are rejected.

7)☒ Claim(s) *4-12,14,15,17 and 18* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 December 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-18, drawn to a process, classified in class 148, subclass 526.

II. Claims 19-28, drawn to an apparatus, classified in class 219, subclass 647.

2. The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice a materially different process, such as a process which involves melting by using heat generated by the induction coil of Invention II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Dean Small, attorney of record, on May 29, 2003 a provisional election was made with oral traverse to prosecute the invention of Group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1, 2, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (PG Publication 2001/0009724) in view of any of Hogg (U.S. Patent 4,390,377), Arnaud et al. (U.S. Patent 6,093,267), or JP 11-289645.

Chen et al. discloses a process which includes coating one or a plurality of conductive wires with a metallic coating, preferably by electroplating (see Chen paragraph [0052]), followed by heat treating of the coated product in order to relieve stress and improve the mechanical properties of the product. The Chen products are to be used as conductive contacts in electronic applications.

Chen does not disclose induction heating as a method of heat treatment. Each of the secondary references indicates that it is well-known in the art to heat treat coated wires by an induction heating process; see Hogg column 8, lines 25-30, Arnaud example 3, or the Abstract

of JP '645. The Hogg and Arnaud patents state that one purpose of the heat treatment is to relieve stress in the coated wires.

Based upon these disclosures of Hogg, Arnaud, or JP '645, it would have been an obvious expedient to one of ordinary skill in the art to employ induction heating as the heat treatment step in the Chen et al. process.

7. Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. in view of Hogg, Arnaud et al., or JP 11-289645, as set forth above, or over this combination of references and further in view of Evans (U.S. Patent 5,350,467).

The prior art as set forth in the preceding section does not disclose heating different portions of the heat treated materials by different amounts, as required by the instant claims. The examiner's position is that:

a) Such a feature would be inherent in any practical heat treatment process such as those of Chen, Hogg, Arnaud, or JP '645, i.e. inevitably some portion of the treated product will be closer to the heating source than other portions and therefore the two portions will be heated by different amounts, and

b) The Evans patent indicates it to be conventional in the art to perform an induction heat treatment process in such a manner that one differentially heat treats different portions of the objects being heated.

Therefore, the features as presently claimed would either be inherent in the process of Chen combined with that of Hogg, Arnaud, or JP '645, or would be considered well-known by one of ordinary skill in the induction heat treating art, as evidenced by Evans.

8. Claims 4-12, 14, 15, 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The remainder of the art cited on the enclosed PTO-892 and 1449 forms is of interest. This art is held to be no more relevant to the claimed invention than the art as applied in the rejections, supra.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (703) 308-2531. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (703) 308-1146. The fax phone number for this Group is (703) 872-9310 for all correspondence except for After Final amendments in which case the Fax number is (703) 872-9311. The Right fax number for this examiner is (703) 872-9039. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW
June 4, 2003